S.N. 09/483,183

## REMARKS

Claims 1-23 are pending in this application.

Claims 1-23 are rejected.


The office action dated April 5, 2004 maintains the rejections of base claims 1, 12, and 18 under 35 USC §103(a) as being unpatentable over Choudhury et al. U.S. Patent No. 5,509,074 in view of Pogue et al. 5,144,667; the rejection of dependent claim 6 under 35 USC §103(a) as being unpatentable over Choudhury et al. in view of Pogue et al. and Peairs U.S. Patent No. 5,717,940; and the rejection of base claim 19 under 35 USC §103(a) as being unpatentable over Choudhury et al. in view of Pogue and Mandelbaum U.S. Patent No. 5,552,897.


Claim 1 recites a method of using a printer to distribute a document stored on a server.  The method includes using the printer to receive an encrypted document from the network; using the printer to decrypt the document; and using the printer to print the decrypted document. Before sending the printer establishes a printer identity with the server.  Claim 1 has been amended to recite <u>that a smart card is used to give an identity to the printer</u>


Choudhury et al. disclose a method in which a document server sends an encrypted document to a printer (col. 4, lines 19-20), and the printer decrypts and prints the document (col. 4, lines 25-26).  The printer uses a decryption key, which resides within the printer (col. 4, line 3-7). Choudhury et al. suggest that the decryption key is programmed into the printer. Choudhury et al. do not teach or suggest that the printer gets its identity from a smart card.


-7-

S.N. 09/483,183

Moreover, Choudhury et al. do not teach or suggest that the printer establishes its identity with a document server. Choudhury et al.'s printer always has the same unique identity. Thus, there is no need and no reason to establish a printer identity with the document server.

According to the office action, Choudhury at col. 4, lines 10-12, states that a printer may have several keys (and, therefore, several identities). According to Choudhury, at col. 4, lines 10-12, "devices" may contain the secret key or keys. Please note that "devices" is plural. Thus, col. 4, lines 10-12 of Choudhury et al. suggests that different devices have different keys, or that different devices have the same key.

Pogue et al. disclose a remote system for unlocking doors in a car. The system 10 includes a remote 14 and a base unit 12. Prior to operation of the system, a secret key (S) is programmed into the remote, and the remote registers with the base unit. Registration includes the base unit sending a public key (P) to the remote, the remote encrypting the public key with the secret key (Q=S(P)), the remote sending the encrypted public key (Q) to the base station, and the base station storing the encrypted public key (Q) along with its copy of (P). The remote does not store the base station's private key (P).

The remote unit broadcasts its ID. When the base unit detects the presence of the remote unit, it challenges the remote to prove its identity. The challenge includes the base station sending the encrypted public key (Q) and a random number (R) to the remote. The remote uses its secret key (S) to decrypt the public key, then uses the decrypted public key to encrypt the random number, and then sends the decrypted random number (P(R)) to the base station. The base station uses its own public key to encrypt the random number, and compares its encrypted random number to the random number encrypted by the

-8-

S.N. 09/483,183

remote. If the numbers match, the identity of the remote is proven, and the base station unlocks the car doors.

The office action acknowledges that Pogue et al. do not describe a printer-server system. However, the office action appears to be "abstracting" Pogue et al. to obtain a general principle, and then applying the general principle to Choudhury et al.'s system. The office action states that "the system for unlocking doors described in Pogue is only an example of the true system, which is Secure remote access as the title describes."

This "abstraction" fails on several fronts. First, Pogue et al. don't teach or suggest a "general principle" or a "true system." They only disclose a car security system. They don't teach or suggest how their car security system can be extended to other types of systems.

Second, the office action finds no suggestion in the prior art for applying the general principle to a printer-server system. The office action cites security, but Choudhury et al.'s system is supposed to be secure. The documents made of record give no reason, incentive or motivation to apply Pogue et al.'s "challenge system" to a printer-server system.

Third, the amendment to claim 1 clearly indicates that the printer gets its identity from a smart card, and, therefore, can have multiple identifies. In Pogue et al.'s remote system, the remote unit does not get its identify from a smart card. The remote unit has the same identify, regardless of who uses it.

Fourth the examiner has not addressed the issue of non-analogous art. Pogue et al. is non-analogous art. Even though an analogy with Pogue et al. can be drawn, Pogue et al. is not necessarily analogous within the meaning of the

-9-

S.N. 09/483,183

MPEP.  MPEP 2141.01(a) states the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." The design of a vehicle security system is not in the field of the applicants' endeavor (distributing and printing of documents), nor is it reasonably pertinent to an architecture for distributing and printing documents. Vehicle security systems are different in structure and function than document distribution and printing systems.  Therefore, Pogue et al. is non-analogous art according to MPEP 2141.01(a).

Mandelbaum was cited in the rejection of claim 19.  Mandelbaum discloses a fax machine with a smart card reader.  A user inserts a smart card in the fax machine in order to gain access to the fax machine.  However, the smart card does not give an identity to the fax machine.

Thus the documents made of record to not teach or suggest the method of claim 1.  Therefore the '103 rejections of claim 1 and its dependent claims 2-11 should be withdrawn.

Claim 6 should be allowed for the additional reason that the documents made of record do not teach or suggest ordering a document prior to establishing the printer identity.  This step adds an additional level of security during the distribution and printing.  Although page 8 of the office action indicates that claim 6 is rejected over the combination of Choudhury et a., Pogue et al., and Peairs, page 3 of the office action modifies that rejection by removing Peairs. Thus, page 3 indicates that claim 6 is rejected under 35 USC §103(a) as being unpatentable over Choudhury et al. in view of Pogue et al.

The office action states that ordering a document prior to establishing the printer identity is "inherent."  However, the office action provides neither evidence

-10-

S.N. 09/483,183

nor explanation of inherency. Evidence and an explanation are respectfully requested. If the examiner is relying on his personal knowledge to establish inherency, he is respectfully requested, pursuant to, MPEP §707 and 37 CFR §1.104(d)(2), to provide an affidavit supporting his personal knowledge.

Claim 11 should be allowed for the additional reason that the documents made of record do not teach or suggest the step of using the printer to indicate status of the printing so that the server can charge for copies that were actually printed. This step implies that the printer sends back a status acknowledgement to the server. Furman, for example, simply uses a server window to give the user feedback that the print job is completed. The status is returned only when requested by a client.

The office action states that claim 11 would be in a better position for allowance if it recited that "the printer sends back a status acknowledgement to the server." Claim 11 has been amended to recite this feature. Claim 11 has also been rewritten in independent form (with some modification) to include the subject matter of original claim 1.

On February 27, 2005, applicants' attorney Hugh Gortler faxed a draft amendment to Examiner Brown. During a telecon with Mr. Gortler on February 28th, Examiner Brown indicated that the amendments above to claim 1 would probably overcome the 'rejections, but would raise new issues. Hence the RCE.

Base claims 12, 18 and 19 were amended after the telecon. These base claims and their dependent claims are also believed to be allowable over the documents made of record.

-11-

S.N. 09/483,183

The examiner is respectfully requested to withdraw the rejections of claims 1-23. If any issues remain, the examiner is encouraged to contact applicants' attorney Hugh Gortler to discuss those remaining issues.

-12-